

Trick 201-KGB/OC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANTS : ROBERT T. TRICK  
SERIAL NO. : 08/100,019  
FILED : July 30, 1993  
FOR : SEALED PACKAGE OF FILM FOR PRODUCING  
FRAMED PHOTOGRAPHS  
ART UNIT : 2851  
EXAMINER : M. Dalakis



August 9, 1999

Hon. Assistant Commissioner for Patents  
Washington, D.C. 20231

**APPELLANT'S REPLY BRIEF ON APPEAL  
PURSUANT TO 37 CFR § 1.193(b)**

SIR:

Appellant respectfully requests entry and consideration of the following reply to the new points raised in the Examiner's Answer.

First, along with this amendment, Appellant has filed an amendment canceling claims 7 and 15. If this amendment is entered, then Appellant submits that this moots the rejection of these claims under 35 USC § 112, second paragraph. Also, Appellant points out that the subject matter of these claims still would be dominated by the independent claims from which claims 7 and 15 depended.

Next, with regard to the prior art rejections, Appellant notes that there is yet another new examiner, who has yet another new theory of the case. Coming so late in the prosecution, perhaps the Examiner should have denoted the new theory as a new ground of rejection, and given Appellant an opportunity possibly to amend the claims or take other appropriate action. However, this was not done.

In any event, Appellant submits that the Examiner's inherency theory is hopelessly flawed.

At the outset, Appellant notes that in a number of places the Examiner states that nowhere in the present claims is it recited that between exposures the film is packaged and sealed as Appellant argues. To the extent that such a recitation would help his case, then Appellant submits that this is implicit in the claim language. As embodied in claim 1, the sealed package already comprises the partially exposed film. Since the package is sealed, the partial exposures must already have been made prior to sealing the package. Appellant does not believe that it is possible to expose film in a sealed package.

Regarding Ames, Appellant repeats that the paper of Ames is not a film. Appellant would call the attention of the Honorable Board to Ames at column 1,

lines 28 and 29, wherein Ames expressly teaches that "I prefer to use a well known type of sensitized paper *instead of film or photographic plates.*" In contrast, there is no evidence of record to support the Examiner's position that persons skilled in the art would consider the term "film" broad enough to embrace paper.

In the first full paragraph on page 6 of the Examiner's Answer, the Examiner says that "[t]he sealed package of Ames comprises the light sealed box B and receptacle R." However, as expressly taught by Ames at column 3, line 8, "[t]he box B holds the undeveloped paper." Also, it is clear from Ames's Figure 1 that box B is situated before cameras C' and C. Therefore, it should also be clear that the paper in box B—even if it could be considered to be film—does not comprise exposed and unexposed portions as required by the present claims. The paper in box B would only contain unexposed portions.

Similarly, receptacle R is situated after cameras C' and C, and, therefore, obviously contains the fully developed paper. As taught by Ames at column 2, lines 105-107, "a suitable receptacle R is provided for receiving the exposed sections of paper P \* \* \*." Therefore, it should also be clear that the paper in receptacle R—even if it could be considered to be film—also does not comprise exposed and unexposed portions as required by the present claims.

Consequently, Appellant submits that the Examiner's theory of inherency as it relates to the Ames patent is clearly in error and should be withdrawn.

Regarding the Guez patent, the Examiner states in the last paragraph on page 6 of the Examiner's Answer that "[o]nce the film is rewound (after the first pre-exposure operation) into the film cartridge, the result is an inherently (light) sealed package of photographic film with an exposed portion and an unexposed portion." However, Appellant submits that even according to this theory the film cartridge is obviously not a "sealed package" as there is an opening in the film cartridge permitting the film to be wound and then rewound. Thus, the film cartridge—even if it could be considered to be a package—is not a sealed package as required by the present claims.

Further on this point, when Guez loads the 35mm film canister into the camera, fresh from its box, there is a 2 1/2" long film tab, called a leader, hanging out of the canister already. This is done at the factory. It is done to facilitate loading the film roll on the take up reel (refer to Guez figure 10 for the typical 35mm camera details). Currently, in 1999, as it might have been at the time Guez filed, the factory leader is of a curved, irregular shape.

Normally, this tab of film gets wrapped around the take up spool so that

when you advance the film forward for each picture, it pulls more film out of the canister to be exposed. This tab is never used for exposing.

Thus, because there is film hanging out of the canister when you first buy it, i.e. the factory made tab, and even though you don't use it for exposing, it is still film that is not sealed in the package. So, even before Guez does his pre-exposures, he does not have a sealed package of film.

When Guez does his pre-exposures and rewinds the film, he still does not have a sealed package of film, for the leader that he creates (by cutting the film, etc Col. 10, Ln. 56-61) is left hanging out of the canister after the rewind. Again, though the leader is not used for exposure, it is still film material, the same as that used for exposing. So, again, Guez does not end up with a sealed package of film.

When Guez loads the film for the first time, he cuts the factory leader off (the factory tab of point 1) above), pulls more fresh film out of the canister and creates a new leader. This is done to create a clean straight edge close to the first top and bottom sprocket holes in the film. Remember, the factory leader can be irregular in shape, uneven, and not have sprocket holes at the top and bottom of the film, so Guez needs to create a new edge that does. Next, when he does his pre-exposures and rewinds the film back to the "start" point indicated by his notches (he's not

clear on the notching method) and stopped by his tape (Col. 11, Ln. 12-16), he still has his leader hanging out of the canister/package. According to the sequence of his process, the notch is made after he creates his leader, so if he rewinds back to that notch, his leader will most definitely be hanging out of the "package". Also, if the tape is working the way it is intended, it will stop the film before it goes back into the canister to keep his leader accessible. Thus, the film is not completely rewound back into the canister after his pre-exposures as his leader edge, though not used for exposing, it still hanging out of the canister/package.

When Guez rewinds his film, if his tape doesn't hold, either by snapping in half or detaching (unsticking) from the film leader, the film will be completely rewound back into the camera, leader and all, leaving no film sticking out with which to attach to the take up reel for the second, post-exposures. If this happens, though the film has been pre-exposed, it can not be re-exposed for the second , post exposure and is rendered useless. Guez even cautions against this happening (Col. 10, Ln 65-68)(Col. 11, Ln.1-2). If this does happen, Guez will not have a usable sealed package of pre-exposed film.

Further, Guez is not specific on certain steps, leaving his process unclear and open to interpretation. This lack of process clarity can result in the FIRST PRE-EXPOSURE being exposed to unwanted light and ruined. In Guez's faulted

process, after he says to notch the film and close the camera cover (Col. 11, Ln 3-9), he does not say to advance the film anymore, an important step he lacks. What he does say is to begin taking the pre-exposures right at that point (Col. 11, Ln 9-10). Since the notches are made with the camera door open, and the film is not asked to be advanced after closing the door, we have just inadvertently pre-exposed to unwanted light, not a portion, but the entire frame of film that was to be used as the first pre-exposure. Not only have we ruined the first frame for future post-exposures, but we have pre-exposed the entire frame, not just a portion of it, which runs counter to Guez's claim of pre-exposing only a portion of the frame (Col.12, Ln.31). The first frame is thus rendered useless with respect to Guez's intended claims. Thus, Guez does not produce a sealed package of film where each photographic frame comprises a first unexposed portion and a second exposed portion, as presently claimed.

Guez' lack of process clarity can result in the FIRST PRE-EXPOSURE, not just his leader alone, NOT BEING RETRACTED INTO THE CANISTER on the rewind and "sealed" within it. Thus, Guez does not produce a sealed package of film where each photographic frame comprises a first unexposed portion and a second exposed portion, as presently claimed.

In Guez's method, he says to attach the tape (adhesive side out) to the take-up

roller, advance the take up roller one frame so the tape wraps onto the spool, attach the newly cut edge of the film to the tape by pressing it on, and then says "The film is then wound as much as desired" (Col.10, Ln.47-63). Being he makes no specification as to how much to wind (i.e. to advance the film) (Col.10, Ln.62-63) one can advance the film by just one frame. As one advances the film by just one frame, two things happen simultaneously. First, the first pre-exposure frame is moved out of the canister and set in proper placement over the camera gate and ready to be exposed. Second, the extra length of tape that was previously free, and attached to nothing, between the take up spool and the leading edge of the film (see Guez figure 10), is now going to adhere to itself and the film as its full length wraps around the take up spool. Then the notches are made, the cover closed and the frames are exposed (Col.11, Ln. 3-12) without advancing the film anymore.

Now upon the rewinding of the film, the adhesive tape that has been wound up on the take-up spool is going to stick to itself and prevent the film from being rewound back into the canister by a distance equal to that which was previously free as discussed above. Thus, the film is not going to be rewound back to it's original position. Thus, the first pre-exposed frame is not going to fully be retracted into the casing (the sealed package), but only partially. The result is that after Guez's process, the first pre-exposed frame is going to be partially hanging out of, and not in, his "sealed package of film" so he will not end up with a "sealed package of pre-exposed



film". In addition, when the user opens the camera to check on the alignment of the notches, while the first pre-exposure is still partially hanging out, they are going to expose the pre-exposure to unwanted light, ruin it and make Guez's film useless. Thus, Guez does not produce a sealed package of film where each photographic frame comprises a first unexposed portion and a second exposed portion, as presently claimed.

Summarizing Guez' steps, they are:

**STEP 1: Load New Roll:**

The (unused) roll of film is placed on the left magazine (Col 10; Ln 48-49).

[Camera OPEN]

**STEP 2: Attach Adhesive Tape:**

Load tape in right take up spool 103, adhesive side up and away from camera. Advance the spool one frame so tape is wound around take up spool 103 and extends over the sprocket 104 and to the left of the sprocket but it does not need to extend into the gate. (Col. 10 Ln 49-50) (The gate is the shutter opening not at the lens, but at the film, it's shown as a rectangular area in fig 10.)

[Camera OPEN]

**STEP 3: Create A New Leader:**

A length of film is pulled out of the roll...and is caused to adhere on the tape

with the first perforation 107 of the film is inserted into the top tooth 108 of the sprocket that is oriented upwards. The film is adhered to the tape by pressing it. (Col. 10 Ln 56-62) (This is where Guez creates his leader as discussed above.)

[Camera OPEN]

**STEP 4: Wind Film As Desired:**

The film is then wound as much as desired. (Col 10, Ln 62-63)

[Camera OPEN]

**STEP 5: Make "Notches":**

A mark, such as a thin line, 109 is engraved inside camera onto the body of the camera...and a corresponding line....is engraved on the film. The two lines form a reference corresponding to the "start" position of the film relative to the camera. (Col 11, Ln3-9)

[Camera OPEN]

**STEP 6: Close Camera & Take Pre-exposures:**

The camera cover is then closed and the frames of the film are exposed.... (Col. 11, Ln 9-10).

[Camera CLOSED]

**STEP 7: Rewind Film To Notches:**

The film is rewound so that the mark on the film as rewound coincides with the mark on the camera thus fixing the position of the rewound film to be exactly the same as the original position when the film was first loaded on the camera.

(Col. 11 Ln 12-16)

[Camera CLOSED then OPENED]

In view of the foregoing, Appellant also submits that the Examiner's theory of inherency as it relates to the Guez patent is also clearly in error and should be withdrawn.

Appellant also points out that Guez requires that for the pre and the post exposures, masks are used. Guez' masks are used out side of the camera and are not part of what the Examiner calls the "sealed package" of film. Thus, Guez need his sealed package of film and the masks to complete the pre-exposure and the post-exposure. These masks are not part of Guez' sealed package. According to the present invention, everything is self-contained in the sealed package.

Appellant has explained above why Ames and Guez do not actually teach sealed packages of film wherein each frame thereof comprises exposed and unexposed portions as required by the appealed claims. The preparation of the instant products requires that the film be packaged and sealed after the partial exposures. There is no such teaching or suggestion in either Ames, Guez or Jones. Accordingly, once the issue of inherency is overcome, it should be clear that there is nothing in the cited combination of references that would have rendered obvious

the instant products to persons skilled in the art.

Appellant points out that even if the Examiner's theory of inherency as regards both Ames and Guez is accepted, claims 10-17 should still be allowable. The Examiner has not alleged anywhere that Ames or Guez inherently teaches the steps of claim 17, upon which claims 10-16 also depend. Step a) of claim 17 requires that the sealed package of film be opened and the film removed. Step b) of claim 17 requires that the film is placed into a camera. The sealed package of film is that according to claim 1, i.e., already containing photographic filming having frames having both exposed and unexposed portions. The Examiner has not pointed to any teaching in Ames that Ames' "sealed package" according to the Examiner's theory, i.e., box B or receptacle R, is to be opened and the paper removed, and placed into a camera. Even if box B were opened, the paper would be unexposed, and, therefore, would not have both exposed and unexposed portions. Even if receptacle R were opened, the paper would be fully exposed, and, therefore, also would not have both exposed and unexposed portion. Moreover, regarding receptacle R, since the paper removed therefrom would already be fully exposed, there would be no reason to then place the fully exposed paper in a camera.

Regarding Guez, there also is no teaching anticipating or rendering obvious claims 10-17. The Examiner has not pointed to any teaching in Guez that Guez's

"sealed package" according to the Examiner's theory, i.e., the film cartridge, is to be opened and the film removed, and placed into a camera. According to the Examiner's theory, the film cartridge is already in a camera between the winding and rewinding operations. Moreover, Guez teaches the elaborate scheme at column 10, line 40, through column 11, line 24, for making sure that the first and second exposures are properly aligned, and this involves taping the film within the camera between exposures. Accordingly, in both cases, there is no teaching or suggestion to remove the film and place it in a camera.

Appellant took the position in the Appellant's principal brief that the claims did not all stand or fall together. The arguments in the two preceding paragraphs are further support for this position. Even if the Examiner's newly developed theory of inherency is upheld with respect to claims 1-9—which Appellant submits it should not—there are additional arguments developed above to support the patentability of claims 10-17.

For the foregoing reasons and for the reasons given in Appellant's principal brief, Appellant respectfully requests that the Honorable Board reverse the final rejections.